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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,547	01/30/2004	Andrew A. Burgess	10759-41	6596

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EXAMINER

MAI, TRI M

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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/768,547	Applicant(s) BURGESS ET AL.	
	Examiner Tri M. Mai	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
 4a) Of the above claim(s) 28-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. Newly submitted claims directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-27, drawn to a golf bag carrier, classified in class 206, subclass 315.3,
- II. Claims 28-34, drawn to a method of using golf clubs, classified in class 206, subclass 315.3,
- III. Claims 35-39, drawn to a method of manufacturing golf bag carrier, classified in class 29

The inventions are distinct, each from the other because of the following reasons:

2. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made from other process, i.e., the helmet can be place on the bag as a cover and then attach to a carrier.

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the process for using the product can be practiced with other products, e.g., baseball bats, hockey sticks, etc. The product as claimed can be used in a differently, i.e., the helmet can be installed on the bag and then secured to the carrier.

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4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. Claims 1-4, 9-11, 21, 22, 23, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bradshaw et al. (6161698). Bradshaw teaches a carrier having a body a helmet attached to the body the helmet configured to extend over the top of the heads of the clubs as claimed. With respect to the limitation "adapted to constrain the golf clubs from moving a

over the structure of Bradshaw. Furthermore, by wrapping the cover tightly as shown in Fig. 12, the clubs are constrained in any direction including the longitudinal direction as claimed. It is noted that the new limitations does not read over the Bradshaw reference, since the helmet of Bradshaw is adjustable and flexible. Furthermore, it is noted that the flexible helmet of Bradshaw provide constraint in any direction, including the orientation perpendicular to shafts of

the golf clubs. With respect to the recitation "top of the heads of the golf clubs" just means a top portion of the golf club, and the two flaps extend over and engage the entire golf club including the top portions of the golf clubs.

Regarding claim 2, note that the term "portion" is broad. In the very least, there is a lower portion being called a shaft portion, and upper portion called the head as claimed. Furthermore, since either portions are planar either having extending portions in both directions including one perpendicular to the golf bag and one parallel to the golf bag.

Regarding claim 3, note the locking mechanism by hooks and loops 60 and 62.

Regarding claim 4, note sleeve 42.

Regarding claim 21, noted that one of the other portion 48 and 58 is the protective member as claimed, i.e., either 48 can 58 can extendible about the golf club heads to engage and secure the side surfaces as claimed.

7. Claims 1-24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw in view of Newman-Butler (1612741), and further in view of Moore, Jr. (1437349). To the degree it is argued that Bradshaw does not teach the helmet. Newman-Butler teaches that it is known in the art to provide a helmet portion at 47. It would have been obvious to one of ordinary skill in the art to provide a helmet portion to provide added protection. If portion 47 of Newman-Butler is the helmet portion then portions 48 and 58 in Bradshaw comprises the protective member as claimed. Moore, Jr. provides further evidence it is desirable to provide the helmet flap 4 for protection of the inside clubs. Thus, to provide a helmet flap in Bradshaw as taught by Moore, Jr. would have been obvious.

8. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rea (3245448). Rea teaches a carrier having a helmet at layer 18, a body with a sleeve at portion 12, and a protective member 26 having two free ends 34 that can overlap. Note that the term "helmet is broad" and the functional limitation does not impart any structures over the layer 18 in Rea. Furthermore, in the very least, layer 18 can constrain any elongated contents in the longitudinal direction as claimed.

Regarding claim 13, note that each of protective and helmet portion having at least one layer.

9. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lickton (6039243). Lickton teaches a golf bag carrier having a body a helmet being the cover 38 and the protective cover being the portion 42 extending circumferentially of the golf bag. It is submitted that the cover 38 can be tied to provide constraint to the golf clubs including the constraining of the golf clubs from moving longitudinally. The sack can be tied at a point below the opening so that it would constraint some of the golf clubs from moving longitudinally. Regarding claim 4, note the rigid sleeve 34 in fig. 14 and the protective member 42 received within the sleeve in Fig. 4 having two buckle ends for overlapping attachment.

10. Claims 6, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lickton in view of either Orestano or Hammill. To the degree it is argued that the two end portions of the protective member 42 are not overlapped, it would have been obvious to one of ordinary skill in the art to provide overlapping straps as taught by either Orestano or Hammill to provide an alternative means for securing the inside bag.

11. Claims 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Parks et al. (6446851). Parks teaches a carrier having a helmet portion layer 7, having a head portion (at 17) and shaft portion (at 18), and a sleeve (portion 30), a protective member 37 having a first free end at 41 and a second free end (the opposite portion in part 10) for overlapping attachment.

12. Claims 9-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (4951818) or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of either Orestano (4878585) or Hammill (6874628). Johnson teaches a body, portions 12A, 14A, 13A, and 62 together forming a sleeve inside the carrier and protective member portions 35 and 36 are positioned within the sleeve as claimed.

In the alternative, to the degree it is argued that the ends of the protective member are not overlapped. It would have been obvious to one of ordinary skill in the art to provide overlapping straps as taught by either Orestano or Hammill to provide an alternative means for securing the inside bag.

13. Claims 1-3, and 16-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Newman-Butler (1612741). Newman-Butler teaches a carrier with an adjustable and flexible helmet at 47 and in an orientation substantially perpendicular to the shafts of the golf clubs, and a protective member 45 with free end overlapping at 46 in Fig. 3. With respect to the carrier carrying another golf bag. The examiner submits that the device in Newman-Butler is capable of accommodating another smaller golf bag inside.

14. Claims 1-4, 16, 18-20, 21-24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan (6401890) in view of Newman-Butler (1612741). Tan teaches a carrier

for a golf bag, and a helmet (the cover) attached to the body via the protective member 4. Tan does not teach the helmet as claimed. Newman-Butler teaches that it is known in the art to provide an adjustable and flexible helmet configured to extend over and engage the top of the heads of the golf clubs (note flap 47 extending over the opening and being perpendicular to the shafts of the clubs). And protective members 45 extendible about the golf club heads to engage the side surfaces of the golf club heads. Together, the protective member and the helmet defining a protective enclosure for the golf club heads. It would have been obvious to one of ordinary skill in the art to provide the bag along with the helmet as taught by Newman-Butler to enable one to transport a different golf bag.

Regarding claim 4, note that portion 4 of Tan is the sleeve as claimed.

15. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Applicant's arguments have been fully considered but they are not persuasive. With respect to Bradshaw, applicant asserts that there is not thing in Bradshaw teaching "extend over and engage the top of the heads of the golf clubs". The examiner submits that one of the flaps 48 and 58 in Bradshaw meets this limitation that either flap extends over and engage the top of the head of the golf clubs. Fig. 6 shows that the two flaps extend over the engage the top of the head of the golf clubs and similar to that of Fig. 12. With respect to the term "extend over", the examiner submits that the either flap extend over the golf club, i.e., it overlay the golf club head shown in Fig. 12. Furthermore, it is noted that in the recitation "engage the top of the heads of the golf clubs". The "top of the heads of the golf clubs" just means a top portion of the golf club,

and the two flaps extend over and engage the top portions of the golf clubs. Furthermore, it is noted that the claim(s) must be distinguished from the prior art in term of structure rather than function. In re Danly, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F. 2d 1464, 1469 (CCPA 1935). See MPEP 2114. in this case, the flexibility of the cover is capable, due to its flexibility, of the function limitation “extend over and engage the top of the heads of the golf clubs” as claimed.

With respect to Rea, applicant asserts that Rea does not describe or suggest a protective member received in a sleeve. Applicant broadly asserts that the lining 12 in Rea is not operable as a sleeve. However, applicant fails to point out exactly what are the differences from the claimed sleeve and the sleeve as taught by Rea. Applicant also asserts that Rea also fails to reach the first end and second end extend circumferentially around the golf bag. It is noted that the claimed recites the golf bag is an intended use structure, and the protective member in Read is capable of circumferentially extending around the golf bag. It seems that applicant is asserting that the golf bag is to be read as a combination with the carrier device by asserting the limitation of the protective member “extend circumferentially around the golf bag.”

With respect to the Johnson reference, applicant asserts that portions 35 and 36 are not received in a sleeve. The examiner submits that portions 12A, 14A, 13A, and 62 together forming a sleeve inside the carrier and portions 36 and 36 are positioned within the sleeve as claimed. With respect to the protection assembly extend around the circumference of a golf bag, the examiner submits that portions 35 and 36 are partially extending around the circumference of

the golf bag. It seems that applicant is asserting that the protecting member to extend the entire circumference of the golf bag. If this is the case, applicant should amend the claim to recite protecting member to extend the entire circumference of the golf bag.

With respect to the helmet, the examiner submits that the claim should be interpreted in the broadest meaning. In this case, portion 8a is the helmet as claimed. It seems from Fig. 6 of the disclosure that the protective portion 500 is attached to the body of the device. This is similar with the interpretation in Johnson where portion 8A is attached to the body of the device. The examiner agrees that the prior art cannot anticipate the claim if there is any structural difference. However, applicant fails to point out any structural differences between the helmet/protective device of Johnson and the claimed device.

With respect to the Lickton rejection, applicant asserts that the sack is not adapted to constrain the golf clubs from moving longitudinally, the examiner disagrees. It is submitted that the sack can be tie to provide constrain to the golf club including the constraining of the golf clubs from moving longitudinally. The sack can be tie at a point below the opening so that it would constraint some of the golf clubs from moving longitudinally. Furthermore, it is noted that applicant is asserting that the golf bag is to be read as a combination with the golf clubs by asserting the limitation of "constrain the golf clubs from moving in a direction along said longitudinal axis." Furthermore, the examiner submits that golf clubs can have a plurality of sizes and the long golf clubs can be constraint by the tying of the loop of the helmet device in Lickton.

With respect to the sleeve, it is noted that the term "sleeve" is broad and portion 42 is the sleeve extending circumferentially of the golf bag as shown in fig. 2. The two portions overlapped at their buckled ends.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tri M. Mai
Primary Examiner
Art Unit 3781

